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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,287	05/11/2007	Shouming Zhong	665690-00005	8081

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DICKINSON WRIGHT PLLC
38525 WOODWARD AVENUE
SUITE 2000
BLOOMFIELD HILLS, MI 48304-2970

EXAMINER

MELLER, MICHAEL V

ART UNIT	PAPER NUMBER
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1655

MAIL DATE	DELIVERY MODE
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04/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/590,287	Applicant(s) ZHONG ET AL.	
	Examiner Michael V. Meller	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-34 is/are pending in the application.
- 4a) Of the above claim(s) 28-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/1/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of **claims 26 and 27 only** in the reply filed on 3/27/2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Thus, claims 28-34 are withdrawn from further consideration as being drawn to non-elected inventions.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1655

Applicant needs to spell out what "RSV infection" refers to. The claims need to be complete on their own and this is simply not the case in these claims. It appears that "RSV" should be respiratory syncytial virus.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Xu (US patent No. (6,083,921).

Xu teaches that *Radix scutellariae* (which is the root of *Scutellaria baicalensis*- see col. 4, lines 30-44) is extracted with ethanol and used to treat RSV infections (same as respiratory syncytial virus), see abstract, col. lines 1-15, col. 2, lines 40-end, col. 3, lines 1-30, col. 4, lines 15-50, col. 5, lines 1-65, col. 6, lines 50-end, col. 7, lines 1-20,

Art Unit: 1655

col. 8, lines 35-50, the examples, col. 14, line 1-col. 15, line 27, col. 19, lines 25-55, the claims.

Whether the extract is taken from the whole plant or a part of the plant does not change the extract since the whole plant is going to contain any compound that a part of the plant contains, thus the whole plant will contain the same extract (compound) as does the part of the plant such as the roots as taught by Xu. Thus, since Xu teaches extraction with ethanol then whether one uses the roots or the whole plant the resulting extract will still contain the active compounds in the extract which will inherently have the activity to treat RSV infections.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xu (US patent No. (6,083,921).

Art Unit: 1655

Xu teaches that *Radix scutellariae* (which is the root of *Scutellaria baicalensis*- see col. 4, lines 30-44) is extracted with ethanol and used to treat RSV infections (same as respiratory syncytial virus), see abstract, col. lines 1-15, col. 2, lines 40-end, col. 3, lines 1-30, col. 4, lines 15-50, col. 5, lines 1-65, col. 6, lines 50-end, col. 7, lines 1-20, col. 8, lines 35-50, the examples, col. 14, line 1-col. 15, line 27, col. 19, lines 25-55, the claims.

In the event that it is seen that the compounds which have the RSV activity are not in the roots (which this examiner highly doubts) then it is submitted that it is clearly obvious to use the entire plant of *Scutellaria baicalensis* since it is noted by Xu that any part of the plant can be used, thus it clearly would have been within the purview of the ordinary artisan to use the whole plant instead of a part of the plant since the whole plant is clearly desirable as noted by Xu, see col. 4, lines 25-35. When Xu states that any suitable part of the plant can be used, this clearly can encompass the whole plant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Meller whose telephone number is 571-272-0967. The examiner can normally be reached on Monday thru Thursday: 9:30am-6:00pm.

Art Unit: 1655

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael V. Meller
Primary Examiner
Art Unit 1655

/Michael V. Meller/
Primary Examiner, Art Unit 1655